REMARKS

Reconsideration and allowance of the subject application in view of the following remarks is respectfully requested.

Claims 1-21 remain pending.

The rejection of claims 1-16 and 19-21 under 35 U.S.C. 103(a) as being unpatentable over <u>Duvall et al.</u> (U.S. Patent 4,742,447), <u>Cornelius et al.</u> (U.S. Patent 6,629,081), and <u>Curry et al.</u> (U.S. Patent 6,105,013) is hereby traversed.

First, the Examiner's asserted applicability of <u>Duvall</u>, <u>Cornelius</u>, and <u>Curry</u> to the presently claimed subject matter is incorrect. None of the references are applicable as the references fail to disclose, either alone or in combination, a teaching of generating kernel audit data. Specifically, <u>Duvall</u> is directed to a method of controlling file input/output operations in a virtual machine, permitting an application program being run on a virtual machine having virtual memory, to address memory as a single-level store, and employing a page fault mechanism to resolve page faults issued by the application program being run on the virtual machine. <u>Cornelius</u> is directed to a method of account settlement utilizing a network. <u>Curry</u> is directed to an electronic module used for secure transactions which is capable of passing information back and forth between a service provider's equipment via a secure, encrypted technique.

The Examiner appears to be improperly picking and choosing from among selected narrow portions of each of the references using applicant's disclosure as a guide. For example, the Examiner's reliance on column 179, lines 57-59 of <u>Cornelius</u> is entirely misplaced as the identified portion of <u>Cornelius</u> refers to a push of information to a user "on the Web" being triggered and initiated by an information server rather than by the user. Additionally, the referred to passages of <u>Cornelius</u> (column 116, lines 37-40, column 82, lines 39-41, and column 97, lines 3-6) asserted as teaching generating an audit record and depositing the audit record with respect to system calls for a kernel audit record actually appear to disclose a development environment capturing design information and not system call parameters. As such, the Examiner appears to be improperly relying on hindsight and selectively applying portions of inapplicable references out of context.

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To rely on a reference under 35 U.S.C. 103, it must be analogous prior art. The Examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993)>; and *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved). Cornelius is neither in the field of applicant's endeavor nor reasonably pertinent to the present particular problem. Nor is the subject matter disclosed in Cornelius reasonably pertinent.

In *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993), the claims were directed to single in-line memory modules (SIMMs) for installation on a printed circuit motherboard for use in personal computers. A reference to a SIMM for an industrial controller was found to be not necessarily in the same field of endeavor as the claimed subject matter even though it related to memories. Because the reference involved memory circuits in which modules of varying sizes may be added or replaced, whereas the claimed invention involved compact modular memories, the reference was found to be in a different field of endeavor. Furthermore, substantial evidence supported the finding that the reference was nonanalogous because memory modules of the claims at issue were intended for personal computers and used dynamic random-access-memories, whereas the reference SIMM was for use in large industrial machine controllers and only taught the use of static random- access-memories or read-only-memories. For at least this reason, the rejection should be withdrawn.

Second, the Examiner has failed to identify a teaching, suggestion, or motivation for making the asserted combination of Cornelius with Duvall. The Examiner asserts that a person of ordinary skill in the art at the time of the invention would have been motivated to combine Cornelius with Duvall "in order to have a structured procedure for processing system calls and

gain wider acceptance of the system." The Examiner further asserts that <u>Duvall</u> and <u>Cornelius</u> teach related applications. As described above, the references teach very different subject matter and are not related applications. Each of the Examiner's assertions is incorrect and neither satisfies the test for obviousness.

Specifically, the Examiner has failed to identify why a person of ordinary skill would be motivated to combine the control of I/O access in a virtual machine of <u>Duvall</u> with the networked account settlement system of <u>Cornelius</u>. Nowhere does <u>Duvall</u> describe a networked account settlement system, nor does Cornelius describe controlling I/O access in a virtual machine. In the Official Action mailed March 18, 2005, the Examiner states generally that a person of ordinary skill would combine the references in order to have a structured procedure for processing system calls and gain wider acceptance of the system as providing motivation for the asserted combination of references. The Examiner is incorrect and has failed to identify a teaching in either reference teaching, suggesting, or motivating the combination of references.

Similarly, with respect to the Examiner's asserted combination of <u>Duvall</u> and <u>Cornelius</u> with <u>Curry</u>, the Examiner has failed to identify a teaching, suggestion, or motivation for making the asserted combination. The Examiner asserts that a person of ordinary skill in the art at the time of the invention would have been motivated to combine Cornelius and <u>Duvall</u> with <u>Curry</u> in order to "provide a means of storing information as a first-in first-out queue, which is of constant size and does not grow larger." The Examiner again asserts that the references teach related applications. For reasons similar to those presented supra with respect to the combination of <u>Duvall</u> and <u>Cornelius</u>, the Examiner is incorrect and has failed to satisfy the test for obviousness.

A statement that combinations of the prior art to meet the claimed invention would have been well within the ordinary skill of the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. See MPEP 2143.01 quoting <u>Ex parte Levengood</u>, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

In accordance with MPEP §2143.01 and <u>Al-Site Corp. v. VSI Int'l Inc.</u>, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999), the Examiner is requested to identify a teaching, suggestion, or motivation in either reference or to provide an affidavit of facts within the personal knowledge of the Examiner per MPEP §2144.03 providing a motivation or suggestion to one of ordinary skill in the art to make the argued combination. The Examiner has neither identified any

teaching in Duvall or Cornelius or Curry motivating or suggesting the asserted combination to a person of ordinary skill in the art nor provided an affidavit because there is no teaching to be found. For at least this reason, the rejection should be withdrawn.

"When an obviousness determination is based on multiple prior art references, there must be a showing of some 'teaching, suggestion, or reason' to combine the references." Winner International Royalty Corp. v. Wang, 53 USPQ2d 1580, 1586 (Fed. Cir. 2000). The Examiner has failed to make such a showing supporting the applied combination of references and therefore the applied combination of references is improper. The Examiner is in error for any of the above reasons and has not made out a prima facie case of obviousness, and the rejection of claim 1 should be withdrawn.

Based on each of the above reasons, withdrawal of the rejection of claim 1 is in order.

Claims 2-16 and 19-21 depend, either directly or indirectly, from claim 1, include further important limitations, and are patentable over the applied combination of references for at least the reasons advanced above with respect to claim 1. The rejection of claims 2-16 and 19-21 should be withdrawn.

The rejection of claims 17 and 18 under 35 U.S.C. 103(a) as being unpatentable over Duvall, Cornelius and Curry and further in view of Cahill (U.S. Patent 6,535,855) is hereby traversed. The above-noted arguments with respect to the applicability and combination of Duvall, Cornelius, and Curry is noted and applies equally to claims 17 and 18. Further, with respect to claim 17, Cahill fails to cure the Examiner-admitted deficiencies of Duvall, Cornelius, and Curry with respect to the tokens being primitive or composed. Cahill, at most, describes a password device token and not a token according to the present claimed subject matter, e.g., the tokenized audit record as claimed in claim 5 from which claim 17 depends. The Examiner's attention is directed to page 14, lines 7-22 and page 33, line 6 through page 37, line 25 for a discussion of tokens in the present specification. Cahill fails to disclose the claimed primitive or composed token of claim 17. For at least this reason, the rejection of claim 17 should be withdrawn.

Further still, the Examiner has failed to make out a prima facie case of obviousness as the Examiner has failed to identify a teaching, suggestion, or motivation for making the asserted combination of Duvall, Cornelius, and Curry with Cahill. The Examiner asserts that a person of

ordinary skill in the art at the time of the invention would have been motivated to combine Cornelius, Duvall, and Curry with Cahill in order to "provide flexibility in defining the tokens used for communication and gain greater acceptance of the system" without identifying any such teaching in any of the references. As described above with respect to the rejection of claim 1, this is incorrect and not the test for obviousness.

For each of the foregoing reasons, the rejection of claim 17 should be withdrawn.

Claim 18 depends indirectly on claim 1, includes further important limitations not disclosed in the applied references, and is patentable over the applied references for at least the reasons advanced above with respect to claim 1. The Examiner-identified portions of Cahill fails to disclose a selecting step based on the outcome of system calls. Cahill at column 6, lines 62-65, column 18, line 66-column 19, line 1, column 19, lines 21-26, and column 24, lines 58-61 fail to describe performing a selecting step based on the outcome of system calls. Based on the foregoing, claim 18 is patentable over the applied combination of references and the rejection should be withdrawn.

All objections and rejections having been addressed, it is respectfully submitted that the present application should be in condition for allowance and a Notice to that effect is earnestly solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 08-2025 and please credit any excess fees to such deposit account.

Respectfully submitted,

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